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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/380,276	08/27/1999	HIDEAKI TADA	Q55589	2406

7590

01/17/2003

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EXAMINER

O HARA, EILEEN B

ART UNIT

PAPER NUMBER

1646

DATE MAILED: 01/17/2003

20

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/380,276

Applicant(s)

TADA ET AL.

Examiner

Eileen B. O'Hara

Art Unit

1646

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 17 December 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 17 December 2002. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following ~~rejection~~^{objections}(s): objections to claims 8 and 22.

4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 1-8 and 11-22.Claim(s) withdrawn from consideration: 9 and 10.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____

Lorraine Spector
LORRAINE SPECTOR
PRIMARY EXAMINER

Continuation of 5. does NOT place the application in condition for allowance because:

The amendment does not overcome the utility rejection, for reasons discussed in the prior office actions and below. Applicants assert that the specification discloses as one of the activities of the proteins of the present invention the ability to induce cell death of hematopoietic, immune and nerve system cells, and point to page 17, lines 6-10 in the specification. Applicants further assert that the publication of Eby et al. supports the assertion that the protein of SEQ ID NO: 4 (which is probably a splice or allelic variant of the protein of Eby et al., named TAJ), has the ability to induce cell death. These arguments have been fully considered but are not persuasive, because although the reference of Eby et al. supports the assertion that the proteins of the instant invention are somehow involved in cell death, it is very cell specific and also differs in mechanism from other TNF receptors. Eby et al. presents evidence that the TAJ protein is expressed specifically in the prostate gland, with only very low expression in tissues such as spleen, thymus, testis, uterus, small intestine colon and peripheral blood leukocytes. Therefore, the specification did not provide adequate support that the proteins of the instant invention could be used to control cell death in the treatment of disease as asserted on page 5 of the amendment. The proteins are expressed in very specific tissues or cells which were not disclosed in the specification, and the Eby et al. publication demonstrates that the apoptotic mechanism is different from that of other TNF receptor family members and induces death in some cells but not others. At the time of filing the specification did not support a utility for the proteins or nucleic acids. For these reasons and those discussed previously, the invention does not have utility according to the current guidelines..